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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,117	11/13/2001	Elliott Farber	14358-315	3442

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WASHINGTON, DC 20004

EXAMINER

SHARAREH, SHAHNAM J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,117

Applicant(s)

FARBER, ELLIOTT

Examiner

Shahnam Sharareh

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-105 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Election/Restrictions

1. Applicant's election of species filed on May 27, 2003 has been fully considered. However, the response was partially non-responsive because no single species or a single compound was elected. Accordingly, Examiner hereby clarifies the earlier requirement made to facilitate expeditious prosecution of the claimed invention.
2. Claims 1-105, in this application are drawn in Markush format, and contain multiple independent and patentably distinct inventions. The invention is primarily directed to various types of emulsifying agent that is materially different from each other. A requirement to provisionally elect a single species is made as provided in MPEP § 803.02.
3. This application contains the following patentably distinct species of emulsifying systems:

Various emulsifying systems can be selected from the following groups:

 - a) Anionic emulsifiers, class 424, subclass 77.02, claims 1-5 in-part, 17-23, 50-57, 77-105.
 - b) Non-ionic emulsifiers that are ethoxylated ethers, class 424, subclass 70.31, claims 1-5 in-part, 6-12, 35-41 in-part, 58-66
 - c) Non-ionic emulsifiers that are ethoxylated esters, class 424, subclass 70.31, claims 1-5 in-part, 35-41 in-part, 67-76.
 - d) Acidic anionic polymers, classified in class 514, subclass 943, or 424, subclass 70.111, claims 1-5 in part, claims 17-41.

- e) Acidic anionic polymers and anionic emulsifiers, classified in class 514, subclass 937, claims 1-5 in-part, 17-23.
- f) Cetyl alcohol and stearic acid, classified in class 514, subclass 938, claims 42-49.
- g) Sodium stearyl lactate and sodium isostearyl lactate classified in class 424, subclass 70.31 or 400, claims 1-5 in-part, 50-57.
- h) Acidic waxes and anionic emulsifiers, classified in class 424, subclass 70.22, claims 1-5 in-part, 77-105.

4. Claims 1 is generic to all claims. Thus, it would only be examined to the extent that it would read on the elected species.

5. Examiner partially agrees with the applicant's statement in Paper No. 7 that claim 1 is generic to all claims. However, this is because the emulsifying systems of claims 2-105 do not exclude anionic or non-ionic emulsifiers, not that all of the claims 2-105 are positively limited to an anionic or non-ionic emulsifier. Thus, Applicant's statement is not entirely accurate. For example, claims 42-49 and 95-99 encompass such emulsifying systems that do not contain any anionic nor non-ionic emulsifiers. Cetyl alcohol and stearic acid are emulsion bases, not an anionic or non-ionic emulsifying agents. Similarly, acidic anionic polymers are generally thickening or suspending agents, not anionic or non-ionic emulsifiers. Subsequently, an election of species is required because each of the emulsifying systems set forth above are directed to a patentably distinct system.

6. Claims that are in a Markush-type format encompass patentably distinct species and are directed to multiple independent and patentably distinct inventions since the species are so unrelated and diverse that a reference anticipating one of the species would not anticipate or render obvious the other species. Further, the species are considered to be independent since they are unrelated in operation, one does not require the other for ultimate use, and specification does not disclose a dependent relationship between them. Moreover, each of the stated species is considered to be patentably distinct from the others on the basis of its properties.

7. For example, in the instant case, the emulsifying system of group (f) is unrelated in operation and properties to the emulsifying system of group (e). Similar distinction exists among all other groups. Thus, the enumerated species are capable of supporting separate patents under 35 U.S.C. 121.

8. In the event that the Markush-type claims are not found to be allowable, the examination of the claims presented will be limited to the Markush-type claims to the extent that they read on the elected species and claims directed solely to the elected species. The claims directed solely to the non-elected species will be held withdrawn from consideration. A requirement to elect a species has been held to a tantamount to a requirement for restriction under 35 U.S.C. 121.

9. To properly respond to this election Applicant is advised to elect a single species from the groups enumerated above. By species is meant a single compound. The compound may be named in any of four ways (or any combination thereof): (a) according to the IUPAC standard, (b) by a pictorial representation of the compound, (c)

by setting forth the specific chemical group that each variable of the Markush group represents, or (d) by naming a claim or an example which itself sets forth a single compound. Thus, if Applicant for example elects group (a), anionic emulsifier, a single compound must be identified as the elected species for the group anionic emulsifiers. Subsequently, the generic claims are examined to the extent that they read on the elected species, unless Applicant provides such evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. If the search for the elected species does not provide any applicable prior art, the search will extend to the next compound until the entire scope of the Markush group is properly searched or a prior art is applied.

10. Thus, Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits. If no generic claim is finally held to be allowable the claims may be restricted to the extent examined. Currently, claims 1 is generic to all claims. Claims 1,6,17,24,35,42,50,58,67,77,95 are independent.

11. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

12. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

13. Should applicant traverse on the ground that the species are not patentably distinct, as stated above, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

14. A telephone call was made to William Slaven on August 8, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-308-4556 for After Final communications. Any inquiry of a general nature or relating to the status of this

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application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123

A handwritten signature in black ink, appearing to be 'Shahnam Sharareh', written in a cursive style.

Shahnam Sharareh, PharmD
Patent Examiner, AU 1617